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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,097	12/22/2000	Craig Mazzagatte	36J.P240	1502
5514	7590	08/25/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ADAMS, JONATHAN R	
			ART UNIT	PAPER NUMBER

2134

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/747,097

**Applicant(s)**

MAZZAGATTE ET AL.

**Examiner**

Jonathan R Adams

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-137 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1, 4, 7, 8-10, 14, 17, 20-22, 26, 29, 32-35, 39, 43, 49-51, 54, 59, 65-67, 70, 74, 80-82, 85, 90, 96-98, 101, 105, 111-113, 116, 121, 127-129, 135-137 rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al., US Patent No 5633932 (hereafter referred to as '932).

3. As to claims 1, 14, 26, 39, 43, 49, 51, 54, 59, 65, 67, 70, 74, 80, 82, 85, 90, 96, 98, 101, 105, 111, 113, 116, 121, 127, 129:

'932 teaches a secure printing system comprising:

- authenticating the recipient / authenticates the intended recipient (Col 2, Line 29, '932)
- providing the recipient exclusive control of the printing device's print capabilities after the recipient has been authenticated / upon receiving authentication the printing node decrypts the document and thereafter prints (Col 6, Line 41 et seq., '932)

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- temporarily deferring print data not intended for the recipient from being printed / document is temporarily stored in buffer memory (Col 5, Line 19, '932)
- printing print data intended for the recipient during a period in which the recipient has exclusive control of the printing device's print capabilities / upon receiving authentication the printing node decrypts the document and thereafter prints (Col 6, Line 41 et seq., '932)

4. As to claim 4, 17, 29:

print data not intended for the recipient is deferred by being rejected by the printing device / await a PIN of the intended recipient before starting a print job (Col 5, Line 36 et seq., '932), a print job by any other recipient would must then be deferred/rejected

5. As to claim 7, 20, 32:

recipient gains exclusive control of the printing device's print capabilities by being authenticated utilizing a smart card device / use some type of authentication token such as a smart card (Col 5, Line 53, '932)

6. As to claim 8, 21, 33:

authenticated utilizing a keypad and entering a user code, a personal identification number, or a password / PIN of the recipient to be entered through a keyboard and number pad (Col 5, Line 37, '932)

7. As to claim 9, 22, 34:

authenticated utilizing a biometric device / Forth authentication technique utilizing biometrics (Col 5, Line 66, '932)

8. As to claim 10, 35:

verifying that the recipient is authorized to obtain exclusive control of the printing device's print capabilities / preventing the printing of a sensitive document at a printing node until the intended recipient authorizes printing (Col 2, Line 63, '932) Authentication techniques to confirm the intended recipient (Col 5, Line 34, '932)

As to claim 50, 66, 81, 97, 112, 128:

Recipient obtains control before the recipient is authenticated / it is inherent that the recipient has control of the print server when using a hardware token before authentication

9. As to claim 135-137:

Authenticated utilizing a hardware token / use some type of authentication token such as a smart card (Col 5, Line 53, '932)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 3, 6, 15, 16, 19, 27, 28, 31, 40-42, 44-46, 56-58, 60-62, 71-73, 75-77, 87-89, 91-93, 102-104, 106-108, 117-120, 123, 124, 132-134 rejected under 35 U.S.C. 103(a) as being unpatentable over '932 in view of Hertling, US Patent No 6757741 (hereafter referred to as '741).

'932 teaches a secure printing system providing an authenticated recipient exclusive access to printing resources. '932 does not teach for the storage location of print data or providing a busy indication for other users' print data or for the network to comprise the internet. '741 teaches for the storage location of print data or providing a busy indication for other users' print data or for the network to comprise the Internet. It would have been obvious to a person of ordinary skill in the art at the time of invention to combine the invention of '741 with the invention of '932. One of ordinary skill in the art would have been motivated to combine the invention of '741 with the invention of '932 because to do so provides expanded functionality to the invention of '932.

12. As to claim 2, 15, 27, 41, 42, 57, 58, 72, 73, 88, 89, 103, 104, 119, 120:  
Print data not intended for the recipient is deferred by the printing device providing a busy indication / print server to respond with the printer response message that informs the queue server that the printer is busy printing (Col 5, Line 56, '741).

13. As to claim 3, 16, 28, 40, 56, 71, 77, 87, 93, 102, 118:

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print data not intended for the recipient is deferred by being temporarily stored  
reference to a print data storage location is sent to a print queue / the queue server  
places the print job ticket in a printing queue (Col 5, Line 51, '741)

14. As to claim 44, 60, 75, 91, 106, 117, 120:

Accessing print data over a network to be printed by the printing device / the queue  
server places the print job ticket in a printing queue (Col 5, Line 51, '741)

15. As to claim 6, 19, 31, 46, 62, 108, 124:

wherein the print data intended for the recipient is stored in a location other than in a  
print queue and a reference to the stored print data location is provided to the print  
queue / the queue server places the print job ticket in a printing queue (Col 5, Line 51,  
'741)

16. As to claim 45, 61, 76, 92, 107, 123, 132, 133, 134:

Network is Internet or intranet / the network may comprise the Internet (Col 3, Line 52,  
'741)

17. Claims 5, 13, 18, 25, 30, 38, 55, 86, and 117 rejected under 35 U.S.C. 103(a) as  
being unpatentable over '932 in view of '741 in further view of Aiello, Jr. et al., US  
Patent No. 6337745 (hereafter referred to as '745).

As to claim 5, 13, 18, 25, 30, 38, 55, 86, and 117:

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18. '932 as modified above teaches a secure printing system using a printing station to authenticate the user before printing. '932 as modified above does not teach for the authenticated intended recipient to select which jobs to print. '745 teaches a user interface for selecting between print jobs at a print server (Col 2, Line 29 et seq., '745). It would have been obvious to a person of ordinary skill in the art at the time of invention to allow the user to select between print jobs as in '745 in the invention of '932 as modified above. One of ordinary skill in the art would have been motivated to allow the user to select between print jobs as in '745 in the invention of '932 as modified above because to do so provides added convenience to the user.

19. Claims 11, 12, 23, 24, 36, 37, 47, 48, 52, 53, 63, 64, 68, 69, 78, 79, 83, 84, 94, 95, 99, 100, 109, 110, 114, 115, 125, 126, 130, and 131, rejected under 35 U.S.C. 103(a) as being unpatentable over '932 in view of '741 in further view of '745 in further view of Motoyama, US Patent No 6581092 (hereafter referred to as '092).

As to claims 11, 12, 23, 24, 36, 37, 52, 53, 68, 69, 83, 84, 99, 100, 114, 115, 130, 131:

20. '932 as modified above teaches a secure printing system. '932 as modified above does not teach to track resources used by the user. '092 teaches a system for tracking various resources used by a user including number of pages used (Col 3, Line 20, '092). It would have been obvious to a person of ordinary skill in the art at the time of invention to track resources used as in the invention of '092 in the invention of '932 as modified above. One of ordinary skill in the art would have been motivated to track



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resources used as in the invention of '092 in the invention of '932 as modified above because in many environments it is helpful to document the consumption of resources.

21. As to claim 47, 63, 78, 94, 109, 125:

Performing a copying operation / It is inherent to the invention of '932 as modified above that a print job is copied to the printer

As to claim 48, 64, 79, 95, 110, 126:

22. '932 as modified above teaches a secure printing system using a printing station.

'932 as modified above does not teach the use of a facsimile operation. The examiner takes official notice as to the use of a combination printer/fax machine for the printing station in the invention of '932 as modified above. It would have been obvious to a person of ordinary skill in the art at the time of invention to use a combination printer/fax machine for the printing station in the invention of '932 as modified above. One of ordinary skill in the art would have been motivated to use a combination printer/fax machine for the printing station in the invention of '932 as modified above because the use of combination printer/fax machines is well known in the art and are very common for use with both local and group printers. Canon, HP, Dell, and Lexmark all make combination printer/fax machines.


23. As to claims 14-46, 49-131, 133, 134, 136, and 137:

Claims 14-46, 49-131, 133, 134, 136, and 137 correspond to claims 1-13, 47, and 48.

**Conclusion**

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R Adams whose telephone number is (703) 305-8894. The examiner can normally be reached on Monday – Friday from 10am to 6pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
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